

DOCKET NO: VISX0011U/US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF:
WILLIAM TELFAIR ET AL.

:CONFIRMATION NO: 5573

EXAMINER: DAVID M. SHAY

GROUP: 3739

APPLICATION NUMBER: 09/307,988

FILED: May 10, 1999

FOR: SHORT PULSE MID-INFRARED PARAMETRIC
GENERATOR FOR SURGERY

REMARKS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Notification of Non-Compliance with 37 CFR 1.192(c) mailed on October 8, 2003 indicated that the appeal brief was not in compliance with 37 CFR 1.192(c). In response, the applicants submit that the original Appeal Brief filed on July 29, 2003 is in full compliance with the provisions of 37 CFR 1.192(c), and that the Notification is, therefore improper.

In the Notification, Examiner Shay states that "[s]tatus of the Amendment After Final not given." The applicants submit that the status of the Amendment After Final rejection is stated in paragraph "D" on page 2 of the Appeal brief of July 29, 2003. Specifically, paragraph "D" states: "An amendment after final rejection is filed concurrently herewith. In this amendment claim 80 is amended. Claim 80 is presented in the 37 CFR 1.192(c)(9) Appendix reflecting claim 80 before and after the instant amendment is entered." Paragraph "D" reflected the correct status of the Amendment After Final rejection at the time the original Appeal Brief was filed.

In the Notification, the examiner further stated that "[t]he Brief should contain a single copy of the claims which are under appeal." The applicants submit that the Appendix contained,

as explained in paragraph "D" of the Appeal Brief, two versions of claim 80, because, at the time the original brief was filed, the appellants did not, and could not have known which of the two versions of claim 80 would be pending when the Appeal was decided. In this regard, note that an Advisory Action indicating that the Amendment After Final rejection would not be entered was mailed on October 17, 2003, which is long after the July 29, 2003 filing date of the original Appeal Brief, and also after the October 8, 2003 mailing date of the Notification of Non-Compliance.

Examiner Shay further stated that there was "[n]o reference to the drawings by figure and element number." In response, the applicants submit that all claims under appeal are drawn to a surgical method. The drawings illustrate various embodiments of an apparatus. Claimed steps are not illustrated in the figures and thus, reference to the figures to illustrate claimed steps is not appropriate. Paragraph "E" on pages 2-4 of the original Brief filed on July 29, 2003 contains appropriate concise explanation of the claimed invention, referring to the specification by page and line numbers. Thus, the examiner's statement is not a basis to object to the Brief.

Therefore, the applicants submit that the Appeal Brief filed on July 29, 2003 was in full compliance with 37 CRF 1.192(c).

The applicants submit herewith a replacement Brief amending (1) paragraph "D" to reflect the status of the Amendment After final as indicated in the Advisory Action mailed October 17, 2003 and (2) the 37 CRF 1.192(c)(9) Appendix to contain only one version of claim 80.

31518

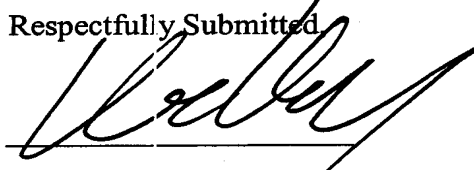
PATENT TRADEMARK OFFICE

Neifeld IP Law, PC
2001 Jefferson Davis Highway
Suite 1001
Arlington, VA 22202

11/4/03

Date

Respectfully Submitted



Richard A. Neifeld
Registration No. 35,299
Irina S. Zernel
Registration No. 43,402

Tel: 703-415-0012
Fax: 703-415-0013
Email: rneifeld@Neifeld.com

Printed: November 4, 2003 (1:54pm)

Y:\Clients\VISX\VISX0011\VISX0011UUS\Drafts\Remarks_031023.wpd